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10/022,194	12/20/2001	Bryan M. Elwood	87289.1741	5973
36734 7590 04/02/2008 BAKER & HOSTETLER LLP WASHINGTON SQUARE, SUITE 1100 1050 CONNECTICUT AVE. N.W. WASHINGTON, DC 20036-5304				
EXAMINER				
BHAT, ADITYA S				
ART UNIT		PAPER NUMBER		
2863				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/022,194

**Applicant(s)**

ELWOOD ET AL.

**Examiner**

ADITYA S. BHAT

**Art Unit**

2863

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-16, 18-30 and 32-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-16, 18-30 and 32-47 is/are rejected.
- 7) ☒ Claim(s) 48 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-16, 18-30, and 32-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kail (USPN 5,959,529). in view of Chiliwnyj et al. (USPN 6,574,679).

With regards to claim 2, Kail (USPN 5,959,529) teaches a device that provides diagnostic and control capability for equipment from a remote location comprising:

an apparatus detached from the equipment comprising a display device, (34, 54; See figure 1) an input device, (28; figure 1) software (82; figure 3) executed by the apparatus and a communications device; (16, 58; See figure 1) and

a hardware controller (22;figure 1) attached to the equipment to enable monitoring of the equipment by the apparatus through the communications device, wherein a unique identifier is stored on an embedded memory of the controller, (Col.6, lines 20-21) wherein the unique identifier is compiled using parts of data accommodating decoding (Col. 3, lines 10-14) specific manufacturing configurations of the equipment, the embedded memory including a database of alarm conditions of the equipment and the environmental conditions(col.3, lines 53-56) of the equipment, readable by the apparatus detached from the equipment, the embedded memory

including embedded random access memory and embedded electrically erasable programmable read-only memory upon which read and write commands are executed. (Col. 3, lines 44-47)

With regards to claim 3, Kail (USPN 5,959,529) teaches the controller is queried by the apparatus (Col. 8, lines 58-63) and wherein information in the unique identifier accommodating diagnosing and servicing of the equipment. (col. 4, lines 48-53)

With regards to claim 4, Kail (USPN 5,959,529) teaches the controller transmits data to the apparatus without being queried (Col. 8, lines 58-67) and wherein the hardware controller being embedded in the equipment and the unique identifier comprising manufactured date of the equipment shipment date of the equipment, device brand of the equipment, device feature set of the equipment; device type of the equipment and operating limits of the equipment. (col. 3, lines 10-12)

With regards to claim 5, Kail (USPN 5,959,529) teaches the data being transmitted is an indication detected by the controller of an equipment problem. (Col. 3, lines 22-32)

With regards to claim 6, Kail (USPN 5,959,529) teaches the controller transmits data in response to the query. (Col. 8, lines 58-63)

With regards to claim 7, Kail (USPN 5,959,529) teaches the controller is instructed by the software code to gather specific data about the equipment and transmitted to the apparatus. (Col. 2, lines 63-65)

With regards to claim 8, Kail (USPN 5,959,529) teaches the data is compiled by the software in a user-preferred manner. (Col. 3, lines 45-46)

With regards to claim 9, Kail (USPN 5,959,529) teaches the data is collected for a specific period of time after which time the data is lost and a new data collection period begins. (Col. 6, lines 60-63)

With regards to claim 10, Kail (USPN 5,959,529) teaches the data is available for review by a user on the apparatus during the specific period of time. (Col. 7, lines 16-18)

With regards to claim 11, Kail (USPN 5,959,529) teaches the software code is programmed with acceptable operational limits for the equipment associated with the identifier. (Col. 2, lines 63-67)

With regards to claim 12, Kail (USPN 5,959,529) teaches the limits are compared to the data retrieved from said controller, if results are within the acceptable operational limits the data no further action is taken, if results are not within acceptable said limits then apparatus carries out a predefined task. (Col. 3, lines 27-30)

With regards to claim 13, Kail (USPN 5,959,529) teaches the predetermined task is alerting the user as to the condition. (Col.3, lines 30-43)

With regards to claim 14, Kail (USPN 5,959,529) teaches the predetermined task is alerting a technician as to the performance of the equipment (Col.3, lines 40-43)

With regards to claim 15, Kail (USPN 5,959,529) teaches the predetermined task is transmitting data to the equipment to adjust certain operational features of the equipment. (364; figure 6)

With regards to claim 16, Kail (USPN 5,959,529) teaches the data is recorded and stored and available for review by the user. (Col. 5, lines 1-6)

With regards to claim 18, Kail (USPN 5,959,529) teaches a method that provides remote diagnostic and control capability for equipment comprising:

monitoring the equipment through a hardware controller attached the equipment (Col. 4, lines 19-23) with a remote apparatus comprised of an input device, (28; figure 1) display device, (34, 54; See figure 1) a communications device (16, 58; See figure 1) and software code executed by the apparatus. (82; figure 3, Col. 7, lines 64-65)

storing a unique identifier on the controller that is attached to the equipment, (Col. 6, lines 20-21) the unique identifier is assembled using an array of data (Col. 3, lines 10-14) with the last bits of data of the unique identifier being evaluated to determine whether the equipment is within acceptable limits of operation for shipment. (col. 1, lines 40-42)

With regards to claim 19, Kail (USPN 5,959,529) teaches selecting with the software code specific data collection wherein the software code records the data of pre-selected features of the equipment. (Col. 2, lines 63-67)

With regards to claim 20, Kail (USPN 5,959,529) teaches querying the controller with request for data, wherein the data is transmitted to the apparatus. (Col. 2-3, lines 67 & 1-4)

With regards to claim 21, Kail (USPN 5,959,529) teaches the step of responding and transmitting a response to the query. (Col. 8, lines 58-64)

With regards to claim 22, Kail (USPN 5,959,529) teaches the step of compiling of the data by the apparatus and stored for a period of time. (Col. 8, lines 58-64)

With regards to claim 23, Kail (USPN 5,959,529) teaches data collection is gathered for a fixed period of time after which the data is removed and a new data period is commenced. (Col. 6, lines 60-63)

With regards to claim 24, Kail (USPN 5,959,529) teaches the data is recorded and stored and available for review. (Col. 5, lines 2-3)

With regards to claim 25, Kail (USPN 5,959,529) teaches the step of comparing the data received from the controller with pre-selected limits, if the results of the comparison are outside of the acceptable limits then the apparatus proceeds with a predefined action; if the results of the comparison are with the acceptable limits then no further action is taken. (Col.2, lines 62-67)

With regards to claim 32, Kail (USPN 5,959,529) teaches a device that provides remote diagnostic and control capability for equipment comprising:

remote means for monitoring the equipment the means for monitoring is an apparatus that is comprised of an input device, (28;figure 1) display device(34,54; See figure 1), a communications device (16, 58;See figure 1) and software coded executed by the apparatus (82;figure 3, Col. 7, lines 64-65) and

means for determining the status of the equipment through the means for monitoring, wherein the means for determining is a hardware device and is attached to the equipment and contains a unique identifier, (Col.4, lines 19-22) the unique identifier (Col. 3, lines 10-14) the embedded memory including a database of alarm conditions of the equipment (Col. 1, lines 40-42) and environmental conditions of the equipment readable by the apparatus detached from the equipment (Col. 4, lines 54-56)

With regards to claim 33, Kail (USPN 5,959,529) teaches a means for determining is a hardware controller. (22; Col.4, lines 19-22)

With regards to claim 34, Kail (USPN 5,959,529) teaches means for selecting with software code specific data collection wherein the software code records the data of pre-selected features of the equipment. (Col.2 lines 63-67) (Col.3, lines 46-49)

With regards to claim 35, Kail (USPN 5,959,529) teaches means for compiling the data from the equipment by querying the controller with request for data. (Col. 8, lines 58-64)

With regards to claim 36, Kail (USPN 5,959,529) teaches data collection is gathered for a fixed period of time after which the data is removed and a new data period is commenced. (Col. 6, lines 55-59)

With regards to claim 37, Kail (USPN 5,959,529) teaches the data is recorded and stored and available for review. (Col. 5, lines 2-3)

With regards to claim 38, Kail (USPN 5,959,529) teaches comparing the data received from the controller with pre-selected limits, if the results of the comparison are outside of the acceptable limits then the apparatus proceeds with a predefined action, if the results of the comparison are with the acceptable limits then no further action is taken. (Col.6, lines 60-64)

With regards to claim 26-30 and 39-43, Kail (USPN 5,959,529) shows various means of generating an alert (Col. 4, lines 48-53)

With regards to claim 45, Kail (USPN 5,959,529) teaches the equipment comprises information on operating limits (col. 1, lines 40-42)



Kail does not appear to explicitly disclose that the unique identifier is embedded with specific manufacturing configuration of the equipment are identified.

Chiliwnyj et al. (USPN 6,574,679) discloses a unique identifier (col. 2, line 59) is embedded with specific manufacturing configuration of the equipment are identified. (Col. 2, lines 62-67)

It would've been obvious to one skilled in the art at the time of the invention to modify the Kail invention to include the embedded specific manufacturing configurations taught by Chiliwnyj et al. in order to provide self-identification for a newly installed analog hardware assembly to a data processing system. (col. 2, lines 39-41)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 44-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kail (USPN 5,959,529) in view of Hayward (USPB 2003/0023703)

With regards to claims 44-47, Kail (USPN 5,959,529) does not specifically disclose specific aspects of the equipment comprise a manufacturer, operating limits, serial number and feature of the equipment. Col.3, lines 11-13 broadly discloses the claim limitations of the above-mentioned claims.

Hayward (USPUB 2003/0023703) discloses specific aspects of the equipment comprises a manufacturer, serial number) and feature of the equipment. (page 2, paragraph 0025)

It would be obvious to one skilled in the art at the time of the invention to modify the Kail invention to include the specific unique identifiers taught by Hayward (USPUB 2003/0023703) in order enhance user support. (page 1, paragraph 0009)

***Allowable Subject Matter***

Claim 48 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed 2/25/2008 have been fully considered but they are not persuasive.

Applicant is reminded that during patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

While the meaning of claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims

must be interpreted as broadly as their terms reasonably allowed. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

In this instance applicant argues Kail teaches monitoring the configuration of the sensor and not the subject being monitored, (Col.2, lines 22-24). Applicant goes on to argue that the Kail reference does not teach compiling the data for decoding (Col.3 lines 10-14), the unique identifier Of the sensor and not the equipment being monitored (Col.2, lines 1-2), the unique identifier accommodates diagnosing and servicing of the equipment (Col.2, lines 53-55) the monitoring apparatus fails to be embedded in the equipment itself (Co1.4, lines 30-34), the evaluation of the identifier being in certain operating limits (Col.2, lines 64-67), a set point view(remote access)(fig 1) setting the local network address through comparison and a field n the unique identifier, a communication recovery mode (Co1.2, lines 53-58) and there is no reason to combine the Kail/Hayward references. In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209

(CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 595 (CC PA) 1969

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jones et al. (USPN 6,219,648) teaches a apparatus and method for monitoring progress of customer generated trouble tickets.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aditya S Bhat whose telephone number is 571-272-2270. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on 571-272-2269. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Aditya Bhat/  
Examiner, Art Unit 2863  
March 29, 2008